

1 BRIGGS LAW OFFICE
2 JEFFREY C. BRIGGS (No. 100369)
3 6464 Sunset Blvd.
4 Suite 715
5 Hollywood, CA 90028
6 Phone: (323) 461-5400
7 Fax: (323) 908-7275
8 Email: jbriggs@jbriggslaw.com

9 Attorney for Defendant and Counterclaimant
10 Firestone Walker, LLC

11 **UNITED STATES DISTRICT COURT**
12 **CENTRAL DISTRICT OF CALIFORNIA, WESTERN DIVISION**

13 WIN IT TOO, INC., etc.,

14 Plaintiff,

15 vs.

16 FIRESTONE WALKER, LLC, etc.,
17 et al.,

18 Defendants.

19

FIRESTONE WALKER, LLC,

20 Counterclaimant,

21 vs.

22 WIN IT TOO, INC.,

23 Counterclaim Defendant.

CASE NO. 2:13-CV-09052-MMM-E

**DEFENDANT FIRESTONE
WALKER, LLC'S ANSWER TO
COMPLAINT, AND
COUNTERCLAIM**

DEMAND FOR JURY TRIAL

24 Defendant and Counterclaimant Firestone Walker, LLC (“Firestone”),
25 answers the complaint of Plaintiff Win It Too, Inc. (“WIT”) and alleges its
26 counterclaim against WIT, as follows:
27
28

ANSWER

1
2 1. Answering paragraphs 1-3 of the Complaint concerning jurisdiction and
3 venue, Firestone admits that the Complaint purports to seek relief under the
4 Lanham Act and under the common law of unfair competition, that this Court has
5 subject matter jurisdiction over the alleged federal and state claims for relief, and
6 that venue is proper in this District, but denies that WIT is entitled to any relief
7 under any such claims, that any acts or omissions or other conduct of Firestone
8 support any of the alleged claims for relief, and any other allegation contained in or
9 implied by any such paragraphs. Firestone further denies that WIT is a proper
10 plaintiff on the grounds that Firestone is informed and believes and on that basis
11 alleges that WIT's corporate status in California is presently suspended, and
12 Firestone alleges that WIT therefore lacks the capacity to sue and that this Court
13 lacks subject matter jurisdiction over WIT with respect to its claims for relief
14 alleged herein.

15 2. Answering paragraph 4 of the Complaint, Firestone is informed and
16 believes that WIT at some point was a corporation organized and existing under the
17 laws of the State of California, but is informed and believes and on that basis
18 alleges that that WIT presently is suspended by the California Secretary of State
19 and therefore lacks the capacity to sue in this Court. Firestone lacks knowledge or
20 information sufficient to form a belief as to the truth of the remaining allegations
21 contained in or implied by such paragraph, and on that basis denies them.

22 3. Answering paragraph 5 of the Complaint, Firestone denies it is a limited
23 liability "corporation," admits it is a California limited liability company, denies
24 that its principal place of business is in Buellton, California, and alleges that its
25 principal place of business is in Paso Robles, California..

26 4. Answering paragraphs 6 - 8 of the Complaint, Firestone admits that WIT
27 purports to sue fictitiously named defendants in addition to Firestone, and
28 understands that WIT will seek to add the names of such additional purported

1 defendants in the future, but denies that WIT is entitled to any relief from any such
2 fictitiously named defendants under any such claims insofar as they have any
3 connection to Firestone, that any acts or omissions or other conduct of any person
4 or entity connected with Firestone support any of the alleged claims for relief
5 against Firestone, that any conduct of any person or entity connected with Firestone
6 has caused WIT any damage, and any other allegation contained in or implied by
7 any such paragraphs. Furthermore, in answering the complaint, Firestone is
8 responding for itself alone, regardless of any plural references to “defendants” in
9 the complaint.

10 5. Answering paragraph 9 of the complaint, Firestone denies that “Global
11 Beer Network” by itself is a federally registered trademark owned by WIT, and
12 lacks knowledge or information sufficient to form a belief as to the truth of the
13 remaining allegations contained in or implied by such paragraph and on that basis
14 denies them.

15 6. Answering paragraph 10 of the complaint, Firestone admits the existence
16 of the described “ ‘912 Registration” and that true copy of same is attached to the
17 complaint as Exhibit A, but denies that it was properly issued, alleges it should be
18 cancelled as set forth in Firestone’s counterclaim submitted herewith, and on
19 information and belief denies that WIT has used the alleged “Living Beer” mark
20 continuously and exclusively and that it is an inherently distinctive and strong mark
21 in association with WIT’s goods. Firestone lacks knowledge or information
22 sufficient to form a belief as to the truth of the remaining allegations contained in or
23 implied by such paragraph and on that basis denies them.

24 7. Answering paragraph 11 of the complaint, Firestone denies the allegations
25 contained therein.

26 8. Answering paragraph 12 of the complaint, Firestone lacks knowledge or
27 information sufficient to form a belief as to the truth of the allegations contained in
28 or implied by such paragraph and on that basis denies them.

1 9. Answering paragraph 13 of the complaint, Firestone admits the
2 allegations contained therein.

3 10. Answering paragraph 14 of the complaint, Firestone denies that it ever
4 was or is aware of WIT's alleged use of "Living Beer" as a trademark, but admits
5 that as of on or about March 21, 2013, it was aware of the '912 Registration and its
6 contents. Firestone lacks knowledge or information sufficient to form a belief as to
7 the truth of the remaining allegations contained in or implied by such paragraph and
8 on that basis denies them.

9 11. Answering paragraph 15 of the complaint, Firestone admits that on or
10 about March 21, 2013, Adam Firestone contacted WIT about Firestone's use of
11 "We Are Living Beer" in connection with the sale of Firestone beer products, and
12 that subsequent discussions occurred and emails were exchanged, that WIT
13 requested Firestone to begin the process of ending its use of "We Are Living Beer,"
14 and that WIT declined to sell its '912 Registration to Firestone. Firestone denies
15 the remaining allegations contained in or implied by such paragraph and on that
16 basis denies them.

17 12. Answering paragraph 16 of the complaint, Firestone denies the allegations
18 contained therein.

19 13. Answering paragraph 17 of the complaint, Firestone lacks knowledge or
20 information sufficient to form a belief as to the truth of the allegation regarding
21 when WIT first learned of Firestone's use of "We Are Living Beer" and on that
22 basis denies said allegation. Firestone admits that it received a letter from WIT in
23 writing that speaks for itself, but denies any allegation or implication in this
24 paragraph that the letter says anything more than what appears on its face.
25 Firestone admits that it has used "We Are Living Beer" in connection with the sale
26 and advertisement of its goods in various media, but alleges that it has discontinued
27 further printing of materials containing such phrase. Firestone denies any
28 remaining allegations contained in or implied by such paragraph and on that basis

1 denies them.

2 14. Answering paragraphs 18 -20 of the complaint, Firestone denies the
3 allegations contained therein.

4 15. Answering paragraph 21 of the complaint, Firestone incorporates by
5 reference its answers to paragraphs 1-20 above, as if set forth in full.

6 16. Answering paragraph 22 of the complaint, Firestone admits the existence
7 of the registration for “Living Beer” and that it was issued to WIT, but denies that it
8 was properly issued and alleges it should be cancelled as set forth in Firestone’s
9 counterclaim submitted herewith.

10 17. Answering paragraph 23 of the complaint, Firestone denies the
11 allegations contained therein.

12 18. Answering paragraph 24 of the complaint, Firestone admits the
13 allegations contained therein.

14 19. Answering paragraph 25 of the complaint, Firestone admits the allegation
15 contained therein, but denies that WIT’s authorization is required.

16 20. Answering paragraphs 26 -31 of the complaint, Firestone denies the
17 allegations contained therein.

18 21. Answering paragraph 32 of the complaint, Firestone incorporates
19 by reference its answers to paragraphs 1-31 above, as if set forth in full.

20 22. Answering paragraphs 33-39 of the complaint, Firestone denies the
21 allegations contained therein.

22 23. Answering paragraph 40 of the complaint, Firestone incorporates
23 by reference its answers to paragraphs 1-39 above, as if set forth in full.

24 24. Answering paragraphs 41-42 of the complaint, Firestone denies the
25 allegations contained therein.

26 25. Answering paragraph 43 of the complaint, Firestone lacks knowledge or
27 information sufficient to form a belief as to the truth of the allegation contained in
28 or implied by such paragraph and on that basis denies it.

1 26. Answering paragraphs 44-49 of the complaint, Firestone denies the
2 allegations contained therein.

3
4 FIRST SEPARATE AND ADDITIONAL DEFENSE

5 1. Firestone's use of "We Are Living Beer" in connection with the sale
6 and advertisement of its goods is a fair use of a descriptive term and all claims for
7 relief are battled in whole or in part by the by the doctrines of fair use, nominative
8 fair use, and/or descriptive use.

9 SECOND SEPARATE AND ADDITIONAL DEFENSE

10 2. WIT's federal registration for "Living Beer" was issued in error and
11 based on false statements to the US Patent and Trademark Office as more fully set
12 forth in Firestone's counterclaim submitted herewith, and therefore should be
13 cancelled.

14 THIRD SEPARATE AND ADDITIONAL DEFENSE

15 3. WIT is estopped from asserting its claims for relief, because others
16 have used and continue to use the phrase to describe their own beer products.

17 FOURTH SEPARATE AND ADDITIONAL DEFENSE

18 4. WIT is precluded from asserting its claims for relief under the doctrine
19 of unclean hands as more fully set forth in Firestone's counterclaim submitted
20 herewith.

21 FIFTH SEPARATE AND ADDITIONAL DEFENSE

22 5. WIT is precluded from asserting its claims for relief because its
23 corporate status, and thus its capacity to sue in this Court, has been suspended.

24 SIXTH SEPARATE AND ADDITIONAL DEFENSE

25 6. The alleged mark upon which all claims are asserted is or has become
26 generic and or lack secondary meaning.

COUNTERCLAIM

Firestone Walker, LLC (“Firestone”) alleges as follows for its counterclaim against Win It Too, Inc. (“WIT”):

JURISDICTION AND VENUE

1. This counterclaim arises under the Lanham Act, specifically 15 USC § 1119, which provides in pertinent part that in any action involving a registered mark, the court may determine the right to registration, order the cancellation of a registration in whole or in part, and otherwise rectify the federal trademark register with respect to the registration of any party to the action..

2. This Court has subject matter over this action pursuant to 15 USC §§ 1119 and 1121.

3. Venue is proper in this District pursuant to 28 USC §§ 1391(b)(1),(2), and/or (3) in that, on information and belief, WIT resides in this District under 28 USC § 1391(c)(2), a substantial part of the events or omissions giving rise to the claim arose in this District, and WIT has subjected itself, by its own action on file herein, to the personal jurisdiction of the court in this District.

PARTIES

4. Firestone is a limited liability company organized and existing under the laws of the State of California, having its principal place of business in Paso Robles, California.

5. On information and belief, WIT is a corporation organized and existing under the laws of the State of California, currently suspended by the California Secretary of State.

FIRST CLAIM FOR RELIEF

(Cancellation and Declaratory Relief)

6. On or about September 8, 2008, WIT filed an application with the US Patent and Trademark Office (“USPTO”) for an alleged mark “Living Beer” on an intent to use basis, and subsequently submitted alleged specimens of use alleging a

1 first use anywhere, and a first use in commerce, on April 1, 2009. A registration
2 was issued for said alleged mark on August 4, 2009.

3 7. WIT has sued Firestone for alleged infringement of the alleged mark
4 “Living Beer” and demanded that Firestone cease all use of same and account to
5 WIT for its profits from the sale of beer under the slogan “We Are Living Beer.”

6 8. On information and belief, Firestone alleges that the specimen of use
7 submitted by WIT in support of its “Living Beer” trademark application was not a
8 proper specimen of use of said alleged mark as a trademark, to wit, it was merely
9 graphic art not displayed on a container for the goods, not displayed on an actual
10 label that was on the goods as packaged, and not otherwise disseminated to the
11 public, and thus did not show use of the mark in the ordinary course of trade on the
12 actual goods sold or transported in commerce.

13 9. On information and belief, Firestone alleges that WIT had not then and
14 has not since used said alleged mark in commerce as a trademark, via the submitted
15 specimen or otherwise.

16 10. On information and belief, Firestone alleges that the term “Living Beer”
17 as applied to “beer” products is merely descriptive as to a certain style of beer and
18 beer-making and thus not subject to appropriation by any one seller of beer, has not
19 been used exclusively by WIT, lacks secondary meaning, and is or has become
20 generic.

21 11. Consequently, WIT’s application and subsequent filings contained false
22 representations to the USPTO regarding its alleged use of the subject alleged mark
23 in commerce and as a trademark.

24 12. On information and belief, Firestone alleges that WIT knew its
25 representations to the USPTO regarding WIT’s use of the subject alleged specimen
26 and mark in commerce, WIT’s exclusive use thereof with respect to beer, and the
27 non-descriptive/non-generic nature of the subject alleged mark, all were false, were
28 intended to deceive the USPTO, and were intended to induce the USPTO’s reliance

1 on the representations in order to secure registration of the subject alleged mark.

2 13. On information and belief, Firestone alleges that the USPTO relied on
3 WIT's false representations in registering the subject alleged mark, and in the
4 absence of such false representations would not have issued the registration.

5 14. On information and belief, Firestone alleges that to the extent WIT ever
6 held a valid registration in the subject alleged mark, it abandoned it due to non-use
7 for a period of at least three years and with the intent not to resume use, and
8 otherwise through a course of conduct that has caused the mark to lose all
9 significance as a mark or indicator of source or origin of WIT's products.

10 15. Firestone has been and continues to be damaged by WIT's false
11 representations to the USPTO and the registration and maintenance of the subject
12 alleged mark.

13 16. An actual controversy exists as to whether WIT has any rights in the
14 subject alleged mark.

15
16 **PRAYER FOR RELIEF**

17 **WHEREFORE**, Firestone prays for relief as follows:

18 1. On WIT's complaint, that WIT take nothing and that the Court enter
19 judgment for Firestone;

20 2. On Firestone's counterclaim, that the Court enter judgment for
21 Firestone, order cancellation of WIT's registration of the alleged mark "Living
22 Beer," and declare that WIT has no rights in and to said mark;

23 3. That the Court declare this to be an exceptional case and award
24 Firestone its full costs and reasonable attorney fees pursuant to 15 USC § 1117; and

25 ///

26 ///

27 ///

28 ///

1 4. That Firestone be awarded any and all such other relief as this Court
2 may deem just and proper.

3
4 Dated: January 31, 2014

JEFFREY C. BRIGGS
BRIGGS LAW OFFICE

5
6 By: /s/ _____
7 Jeffrey C. Briggs
8 Attorney for Defendant and
9 Counterclaimant Firestone Walker, LLC
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25
26
27
28

1 DEMAND FOR JURY TRIAL

2 Defendant and counterclaimant Firestone Walker, LLC, demands a jury trial
3 with respect to all issues so triable.

4 Dated: January 31, 2014

5 JEFFREY C. BRIGGS
6 BRIGGS LAW OFFICE

7 By: /s/ Jeffrey C. Briggs
8 Attorney for Defendant and
9 Counterclaimant Firestone Walker, LLC
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25
26
27
28